REMARKS

In the Office Action dated July 8, 2003, Examiner Winkler imposed a restriction requirement under 35 U.S.C. §121 against claims 1-54 and required that an election be made between one of the following groups:

Group I, drawn to claims 1-16, drawn to a chimeric polypeptide, classified in class 424, subclass 185.1;

Group II, drawn to claims 17-22, drawn to a polynucleotide encoding a chimeric polypeptide, classified in class 536, subclass 23.4;

Group III, drawn to claims 23-33, drawn to an antibody that binds the chimeric polypeptide, classified in class 530, subclass 389.1;

Group IV, claims 34-35, 39-44, drawn to a method of producing an antibody to the chimeric polypeptide, classified in class 435, subclass 7.1;

Group V, drawn to claims 36-38, drawn to a method of inhibiting viral infection in a human subject, classified in class 435, subclass 5.

Group VI, drawn to claims 45-51, drawn to a method of identifying an agent that inhibits the interaction between a virus and a co-receptor, classified in class 435, subclass 4; and

Group VII, drawn to claims 52-54, drawn to a method of identifying a chimeric polypeptide that inhibits viral infection, classified in class 424, subclass 185.

Further, Examiner Winkler requested that the claims of Group I, III, and IV be further limited to one of the following species (A)- (I).

(A) SEQ ID NO: 13 which comprises SEQ ID NO: 28 (HIV) and 26
(B) SEQ ID NO: 2 which comprises SEQ ID NO: 24 (HIV) and 26
(C) SEQ ID NO: 4 which comprises SEQ ID NO: 30 (HIV) and 26
(D) SEQ ID NO: 6 which comprises SEQ ID NO: 30 (HIV) and 20
(E) SIV
(F) FIV
(G) FeLV
(H) FPV
(I) herpes virus

Applicants traverse such a restriction requirement.

Clearly, the product claims and method of using the products are not patentably distinct from each other because one having a method of using the instantly claimed polypeptides would obviously have to have the peptides to perform the method. Thus, the polypeptides are not patently distinct from the method of making and/or using the polypeptides. The interdependence of the polypeptide product claims and the method of use thereof is confirmed --indeed, it is mandated-- by virtue of the fact that the description

requirements of 35 U.S.C. §112 compel disclosure of different aspects of the invention in the one application which applicants have filed.

In addition, the courts have recognized that it is in the public interest to permit an applicant to claim several aspects of his/her invention together in one application, as the applicant has done herein. The CCPA has observed:

> We believe the constitutional purpose of the patent system is promoted by encouraging applicants to claim, and therefore to describe in the manner required by 35 U.S.C. §112 all aspects as to what they regard as their invention, regardless of the number of statutory classes involved. *In re Kuehl,* 456 F.2d 658, 666, 117 U.S.P.Q. 250, 256 (CCPA 1973).

This interest is consistent with the practical reality that a sufficiently detailed disclosure supporting claims to one aspect of an invention customarily is sufficient to support claims in the same application to other aspects of the invention.

It is vital to all applicants that restriction requirements issue only with the proper statutory authorization, because patents issuing on divisional applications that are filed to prosecute claims that the Office held to be independent and distinct can be vulnerable to legal challenges alleging double patenting. The third sentence of 35 U.S.C. §121, which states that a patent issuing on a parent application "shall not be used as a reference" against a divisional application or a patent issued thereon, does not provide comfort to an applicant against such allegations. The Court of Appeals for the Federal Circuit has declined to hold that §121 protects a patentee from an allegation of same-invention double patenting, *Studiengesellschaft Kohle mbH v. Northern Petrochemical Co.,* 784 F.2d 351, 355, 228 U.S.P.Q. 837, 840 (Fed. Cir. 1986); and in *Gerber Garment Technology Inc. v. Lectra Systems Inc.*, 916 F.2d 683, 16 U.S.P.Q. 2d 1436 (Fed. Cir. 1990) that court held that §121 does not insulate a patentee from an allegation of "obviousness-type" double patenting, and in fact affirmed the invalidation on double patenting grounds of a patent that had issued from a divisional application filed following a restriction requirement. Furthermore, it is far from clear that the step of filing a terminal disclaimer is available to resolve a double patenting issue that arises after the issuance of patent on the divisional application.

All these considerations indicate that the imposition of a restriction requirement with inadequate authority can lead to situations in which an applicant's legitimate patent rights are exposed to uncertainty and even extinguished. Accordingly, to protect a patentee's rights and to serve the public's interest, the Office is not to require restriction in cases, such as the present application, wherein various aspects of a unitary invention are claimed.

In view of the foregoing discussion, reconsideration for the withdrawal of the requirement for restriction is courteously requested. In the event the requirement is adhered to, applicants provisionally elect with traverse, the product claims of Group I including claims 1-16 and newly added product claim 55. Applicants further select species (C), which includes SEQ ID NO. 4 comprising a viral coat (SEQ ID NO. 30) - spacer - a viral receptor (SEQ ID NO. 26).

In accordance with Office guidelines recited in MPEP Section 821.04, when elected product claims of Group I are found to recite patentable subject matter then all method claims for making and/or using the products may be rejoined and examined in this one application provided the method of making and using claims recite the product found to be patentable during examination of the elected invention. Thus understood, applicants request that when the product claims of Group I are found to recite patentable subject matter, non-elected claims of Groups IV, V, VI and VII and newly added method claims 56 and 57 be rejoined.

It is requested that all non-elected and withdrawn claims be held in abeyance and reconsidered for rejoinder upon finding of allowable subject matter relative to the elected claims, or alternatively, with reservation of the right to file divisional application(s) directed to the subject matter of those claims that have been cancelled herein.

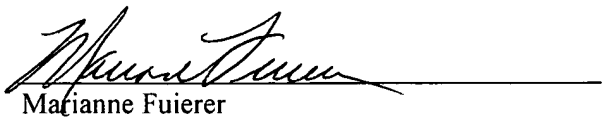
Petition for Extension of Time/Fees Payable

The applicants hereby petition for a one (1) month extension of time, extending the deadline for responding to the July 8, 2003 Office Action from August 8, 2003 to September 8, 2003. The entry of this petition results in a petition fee of $55.00. Also, three new dependent claim has been added beyond the number for which a fee has previously been paid, resulting in an added claim fee of $27.00. A check in the amount of $82.00 is submitted herewith in payment of the petition fee for a one-month extension and the additional claims. The U.S. Patent and Trademark Office is hereby authorized to charge any additional amount necessary to the entry of this amendment, and to credit any excess payment, to Deposit Account No. 08-3284 of Intellectual Property/Technology Law.

Conclusion

It therefore is requested that examination and prosecution proceed on the merits, consistent with this Response. In the event that any issues remain, Examiner Winkler is requested to contact the undersigned attorney at (919) 419-9350 to resolve same.

Respectfully submitted,



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